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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,605	04/14/2004	Atsumasa Mizuno	1086.1199	5079
21171	7590	05/28/2008	EXAMINER	
STAAS & HALSEY LLP			SENSENIG, SHAUN D	
SUITE 700				
1201 NEW YORK AVENUE, N.W.			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			4176	
			MAIL DATE	DELIVERY MODE
			05/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/823,605	MIZUNO, ATSUMASA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shaun Senenig	4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>20040414 and 20080125</u> .	6) <input type="checkbox"/> Other: ____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-10, drawn to a program, fail to satisfy the requirements for statutory subject matter eligibility because they are considered to be drawn merely to the production and/or manipulation of non-functional descriptive material, effecting no “useful, concrete, and tangible result.” To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, which is indeed the case with the instant claims, but also, (2) produce or effect some useful, concrete, and tangible result, which is in fact not *necessarily* the case with the instant claims, since the claims read on just a source code file (non-functional descriptive material) stored on a computer readable medium, as opposed to machine executable instructions (functional descriptive material), which could potentially effect some useful, concrete, and tangible result. It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea.

*In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). See MPEP §2106.01(I).

***Claim Rejections - 35 USC § 112, First Paragraph***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1-15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since, the specification fails to give sufficient guidance or direction as to how a user can determine whether a customer is qualified or not, a user would not be able to make or use the claimed invention without undue experimentation.

***Claim Rejections - 35 USC § 112, Second Paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been deemed to solely comprise conditional language, which is therefore not required, since only one possible alternative is recited (Claim 1, line 11; Claim 3, line3; Claim 6, line 11; Claim 8, line 2; Claim 11, line 11; and Claim 13, line 2).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Namiki et al. (Patent No. JP 2002175431 A) (hereafter referred to as Namiki).

8. In regards to **claims 1, 6 and 11**, Namiki discloses:

9. A support method for transition between portable telephone companies using a computer, comprising:

- (a) a transition request reception step which receives a request for transition between portable telephone companies from a customer terminal; ([0060] and [0061])
- (b) a determination step which determines whether a customer is qualified or not; ([0060] and [0061])
- (c) an after-transition service information presentation step which, if it is determined that the customer is qualified, presents information about an after-transition

service equivalent to a service contracted before transition and about the contract to the customer terminal; ([0060] and [0061]) and

(d) a service contract step which receives contract information for the after-transition service from the customer terminal to conclude the contract, the service contract step notifying the customer terminal of the result. ([0060] and [0061]).

10. In regards to **claims 2, 7 and 12**, Namiki discloses:

11. A support method for transition between portable telephone companies using a computer, wherein the service contract step includes, after conclusion of the contract, sending a program for performing environment setting of the contracted services to a portable telephone terminal of the customer. ([0060] and [0061]).

12. In regards to **claims 3, 8 and 13**, Namiki discloses:

13. A support method for transition between portable telephone companies using a computer, wherein the after-transition service information presentation step includes, if a service before transition is available continuously, presenting information on a continuing contract with a service company, the after-transition service information presentation step including, if the service before transition is unavailable continuously, presenting information on a new contract with another service company equivalent thereto. ([0060] and [0061]).

14. In regards to **claims 4, 9 and 14**, Namiki discloses:

15. A support method for transition between portable telephone companies using a computer, wherein the determination step includes, if it is determined that the customer

is qualified, notifying a computer in an after-transition portable telephone company of the result of the determination to start the service. ([0060] and [0061])

In regards to **claims 5, 10 and 15**, Namiki discloses:

16. A support method for transition between portable telephone companies using a computer, wherein interactions with the customer terminal in the transition request reception step, the determination step, the after-transition service information presentation step and the service contract step are performed via a computer of a portable telephone company which is the destination of transition. ([0060], [0061] and [0064])

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kende et al. (Pub. No. 2002/0120540 A1) and Schlect et al. (Patent No. 6,035,285).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./  
Examiner, Art Unit 4176  
May 15, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 4176